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09/589,084	06/08/2000	Yoshikazu Kobayashi	071671/0153	9809

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EXAMINER

LAFORGIA, CHRISTIAN A

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 05/14/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/589,084

Applicant(s)

KOBAYASHI, YOSHIKAZU

Examiner

Christian La Forgia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☒ Claim(s) 8-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. The preliminary amendment filed on 8 June 2000 is noted and made of record.
2. Claims 1 through 18 are presented for examination.

Drawings

3. The drawings were received on 6 June 2000 are approved by the Examiner.
4. The Patent and Trademark Office no longer makes drawing changes. See 1017 O.G. 4.

It is applicant's responsibility to ensure that the drawings are corrected. Corrections must be made in accordance with the instructions below.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

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Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.185(a). Failure to take corrective action within the set (or extended) period will result in **ABANDONMENT** of the application.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 8, 9, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1 through 18 are rejected under 35 U.S.C. 102(e) as being anticipated by United States Patent No. 6,222,859 to Yoshikawa, (hereinafter Yoshikawa).

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9. As per claim 1, Yoshikawa teaches a telephone communication system comprising a public network (Figures 1, 2 [block TEL151], 3 [blocks SW1, SW2, SWA, SWB]; column 2, lines 18-28; column 5, lines 52-59),
10. an internet service provider network and a plurality of telephone sets accommodated in the public network (Figures 2 [blocks NET151, TEL151, M151, M152, M153], 3 [blocks 2, 4, ISP-A, ISP-B]; column 2, lines 18-28; column 5, lines 35-67),
11. wherein when a calling telephone set as an internet service provider network subscriber provides connection point data for making internet service telephone communication to a called telephone set via a public network, the called telephone set receiving the connection point data connects itself to an internet service provider network according to the connection point data, and then the calling telephone set connects itself to the internet service provider network (Figures 3, 5, 6, 7, 10, 11, 12, 13; column 5, lines 36-67; column 7, lines 2-42; column 10, line 37 to column 11, line 16).
12. As per claim 2, Yoshikawa teaches a telephone communication system comprising a public network (Figures 1, 2 [block TEL151], 3 [blocks SW1, SW2, SWA, SWB]; column 2, lines 18-28; column 5, lines 52-59),
13. an internet service provider network and a plurality of telephone sets accommodated in the public network (Figures 2 [blocks NET151, TEL151, M151, M152, M153], 3 [blocks 2, 4, ISP-A, ISP-B]; column 2, lines 18-28; column 5, lines 35-67),

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14. wherein when a calling telephone set as an internet service provider network subscriber provides connection point data for making internet service telephone communication to a called telephone set via a public network, the called telephone set receiving the connection point data connects itself to an internet service provider network according to the connection point data, and then the calling telephone set connects itself to the internet service provider network (Figures 3, 5, 6, 7, 10, 11, 12, 13; column 5, lines 36-67; column 7, lines 2-42; column 10, line 37 to column 11, line 16),

15. the connection point data including at least an IP address in the internet service provider network and the telephone number of a point to be connected to the internet service provider network (Figures 3, 5, 6, 7, 10, 11, 12, 13; column 5, lines 36-67; column 7, lines 2-42; column 10, line 37 to column 11, line 16).

16. As per claim 3, Yoshikawa teaches a telephone communication system comprising a public network (Figures 1, 2 [block TEL151], 3 [blocks SW1, SW2, SWA, SWB]; column 2, lines 18-28; column 5, lines 52-59),

17. an internet service provider network and a plurality of telephone sets accommodated in the public network (Figures 2 [blocks NET151, TEL151, M151, M152, M153], 3 [blocks 2, 4, ISP-A, ISP-B]; column 2, lines 18-28; column 5, lines 35-67),

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18. wherein when a calling telephone set as an internet service provider network subscriber provides connection point data for making internet service telephone communication to a called telephone set via a public network, the called telephone set receiving the connection point data connects itself to an internet service provider network according to the connection point data, and then the calling telephone set connects itself to the internet service provider network, the connection point data including at least an IP address in the internet service provider network and the telephone number of a point to be connected to the internet service provider network (Figures 3, 5, 6, 7, 10, 11, 12, 13; column 5, lines 36-67; column 7, lines 2-42; column 10, line 37 to column 11, line 16),

19. a push-button telephone set having various function keys being provided between each of the plurality of telephone sets and the public network with a function of sending out a call from each telephone set (Figures 3, 4 [block 14], 5, 6, 7, 10, 11, 12, 13; column 5, lines 36-67; column 6, lines 20-51; column 7, lines 2-42).

20. Regarding claim 4, Yoshikawa teaches wherein the functions of each telephone set are executed on a personal computer (column 6, lines 5-6).

21. Regarding claim 5, Yoshikawa teaches wherein the functions of each telephone set are executed with an IVR (interactive voice response) unit or a facsimile data server or a voice recognition dialer or a voice mail (Figure 4 [blocks 17, 17S, 17M]; column 6, lines 5-10; column 6, lines 20-55; column 6, line 66 to column 7, line 22).

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22. Regarding claim 6, Yoshikawa teaches which comprises:

23. a ten-key unit having dial keys and a function key for indicating an internet telephone service (Figure 4 [block 14]; column 6, lines 20-42);

24. a display unit for displaying a call arrival notification and results of various processes in the telephone set (Figure 4 [block 15]; column 6, lines 32-42);

25. an accumulating unit for storing telephone number data and access identifier data of internet connection points to be connected by the calling and called sides (column 8, lines 31-48; column 9, lines 51-67; column 11, lines 27-40; column 13, lines 15-38);

26. a voice codec to be started by a command for voice communication in the internet (Figure 4 [block 18]; column 6, lines 52-55); and

27. a telephone set control unit for detecting depressed push-buttons in the ten-key unit, obtaining the connection point data from the accumulating unit, sending out dial data and connection point data via the public network, starting the voice codec when the dialed side has been connected to the internet service provider network and, upon arrival of a call, retrieving for the connection point data of the calling side, effecting connection of the own side to the internet service provider network by retrieving and referring to the accumulating unit according to the connection point data and informing the calling side of the connection (Figures 3, 5, 6, 7, 10, 11, 12, 13; column 5, lines 36-67; column 7, lines 2-42; column 10, line 37 to column 11, line 16).

28. Regarding claim 7, Yoshikawa teaches wherein each telephone set further comprises an encryption unit for permitting exchange of connection point data in terms of ciphers (column 7,

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lines 32-43; column 9, lines 5-19; column 9, lines 51-62; column 10, line 55 to column 11, line 25).

29. As per claim 8, Yoshikawa teaches an Internet communication method comprising steps of:

30. in response to provision, by a calling telephone set as an internet service provider network subscriber, of connection point data for making internet service telephone communication to a called telephone set via a public network, the called telephone set receiving the connection point data connects itself to an internet service provider network on the basis of the connection point data, and then the calling telephone set connects itself to the internet service provider network (Figures 3, 5, 6, 7, 10, 11, 12, 13; column 5, lines 36-67; column 7, lines 2-42; column 10, line 37 to column 11, line 16).

31. As per claim 9, Yoshikawa teaches an Internet communication method comprising steps of:

32. in response to provision, by a calling telephone set as an internet service provider network subscriber, of connection point data for making internet service telephone communication to a called telephone set via a public network, the called telephone set receiving the connection point data connects itself to an internet service provider network on the basis of the connection point data, and then the calling telephone set connects itself to the internet service provider network (Figures 3, 5, 6, 7, 10, 11, 12, 13; column 5, lines 36-67; column 7, lines 2-42; column 10, line 37 to column 11, line 16),

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33. the connection point data including at least an IP address in the internet service provider network and the telephone number of a point to be connected to the internet service provider network (Figures 3, 5, 6, 7, 10, 11, 12, 13; column 5, lines 36-67; column 7, lines 2-42; column 10, line 37 to column 11, line 16).

34. As per claim 10, Yoshikawa teaches an Internet communication method comprising steps of:

35. in response to provision, by a calling telephone set as an internet service provider network subscriber, of connection point data for making internet service telephone communication to a called telephone set via a public network, the called telephone set receiving the connection point data connects itself to an internet service provider network on the basis of the connection point data, and then the calling telephone set connects itself to the internet service provider network (Figures 3, 5, 6, 7, 10, 11, 12, 13; column 5, lines 36-67; column 7, lines 2-42; column 10, line 37 to column 11, line 16),

36. the connection point data including at least an IP address in the internet service provider network and the telephone number of a point to be connected to the internet service provider network, a push-button telephone set having various function keys being provided between each of the plurality of telephone sets and the public network with a function of sending out a call from each telephone set (Figures 3, 5, 6, 7, 10, 11, 12, 13; column 5, lines 36-67; column 7, lines 2-42; column 10, line 37 to column 11, line 16).

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37. Regarding claim 11, Yoshikawa teaches wherein the functions of each telephone set are executed on a personal computer (column 6, lines 5-6).

38. Regarding claim 12, Yoshikawa teaches wherein the functions of each telephone set are executed on a personal computer (column 6, lines 5-6).

39. Regarding claim 13, Yoshikawa teaches wherein the functions of each telephone set are executed with an IVR (interactive voice response) unit or a facsimile data server or a voice recognition dialer or a voice mail (Figure 4 [blocks 17, 17S, 17M]; column 6, lines 5-10; column 6, lines 20-55; column 6, line 66 to column 7, line 22).

40. Regarding claim 14, Yoshikawa teaches wherein the functions of each telephone set are executed with an IVR (interactive voice response) unit or a facsimile data server or a voice recognition dialer or a voice mail (Figure 4 [blocks 17, 17S, 17M]; column 6, lines 5-10; column 6, lines 20-55; column 6, line 66 to column 7, line 22).

41. Regarding claim 15, Yoshikawa teaches which comprises:

42. a ten-key unit having dial keys and a function key for indicating an internet telephone service (Figure 4 [block 14]; column 6, lines 20-42);

43. a display unit for displaying a call arrival notification and results of various processes in the telephone set (Figure 4 [block 15]; column 6, lines 32-42);

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44. an accumulating unit for storing telephone number data and access identifier data of internet connection points to be connected by the calling and called sides (column 8, lines 31-48; column 9, lines 51-67; column 11, lines 27-40; column 13, lines 15-38);
45. a voice codec to be started by a command for voice communication in the internet (Figure 4 [block 18]; column 6, lines 52-55); and
46. a telephone set control unit for detecting depressed push-buttons in the ten-key unit, obtaining the connection point data from the accumulating unit, sending out dial data and connection point data via the public network, starting the voice codec when the dialed side has been connected to the internet service provider network and, upon arrival of a call, retrieving for the connection point data of the calling side, effecting connection of the own side to the internet service provider network by retrieving and referring to the accumulating unit according to the connection point data and informing the calling side of the connection (Figures 3, 5, 6, 7, 10, 11, 12, 13; column 5, lines 36-67; column 7, lines 2-42; column 10, line 37 to column 11, line 16).
47. Regarding claim 16, Yoshikawa teaches which comprises:
48. a ten-key unit having dial keys and a function key for indicating an internet telephone service (Figure 4 [block 14]; column 6, lines 20-42);
49. a display unit for displaying a call arrival notification and results of various processes in the telephone set (Figure 4 [block 15]; column 6, lines 32-42);
50. an accumulating unit for storing telephone number data and access identifier data of internet connection points to be connected by the calling and called sides (column 8, lines 31-48; column 9, lines 51-67; column 11, lines 27-40; column 13, lines 15-38);

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51. a voice codec to be started by a command for voice communication in the internet

(Figure 4 [block 18]; column 6, lines 52-55); and

52. a telephone set control unit for detecting depressed push-buttons in the ten-key unit, obtaining the connection point data from the accumulating unit, sending out dial data and connection point data via the public network, starting the voice codec when the dialed side has been connected to the internet service provider network and, upon arrival of a call, retrieving for the connection point data of the calling side, effecting connection of the own side to the internet service provider network by retrieving and referring to the accumulating unit according to the connection point data and informing the calling side of the connection (Figures 3, 5, 6, 7, 10, 11, 12, 13; column 5, lines 36-67; column 7, lines 2-42; column 10, line 37 to column 11, line 16).

53. Regarding claim 17, Yoshikawa teaches wherein each telephone set further comprises an encryption unit for permitting exchange of connection point data in terms of ciphers (column 7, lines 32-43; column 9, lines 5-19; column 9, lines 51-62; column 10, line 55 to column 11, line 25).

54. Regarding claim 18, Yoshikawa teaches wherein each telephone set further comprises an encryption unit for permitting exchange of connection point data in terms of ciphers (column 7, lines 32-43; column 9, lines 5-19; column 9, lines 51-62; column 10, line 55 to column 11, line 25).

Claim Objections

55. Claims 8, 9, and 10 are objected to because of the following informalities: The claims are replete with terms that are not clear, concise and exact. Examples of some unclear, inexact or verbose terms used in the specification are: "in response to provision, by a calling telephone set as an internet service provider network subscriber, of connection point data for making internet service communication to a called telephone set via a public network."

56. Appropriate correction is required.

Conclusion

57. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

58. The following patents are cited to further show the state of the art with respect to telephone-to-IP calls, such as:

United States Patent No. 6,021,184 to Yoshikawa, which is cited to show a computer with a telephone apparatus connected to a communication terminal.

United States Patent No. 4,470,963 to Eckley, which is cited to show a voice and data communication system.

United States Patent No. 6,240,179 to Balatoni et al., which is cited to show voice and data communications.

United States Patent No. 5,905,794 to Gunn et al., which is cited to show a caller identification system.

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59. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian La Forgia whose telephone number is (703) 305-7704.

The examiner can normally be reached on Monday thru Thursday 7-5.

60. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (703) 305-9648. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7240 for regular communications and (703) 746-7239 for After Final communications.

61. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Christian LaForgia
Patent Examiner
Art Unit 2155

clf
May 5, 2003


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100